AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
P. O. Box 7599
Loveland, Colorado 80537-0599

ATTORNEY DOCKET NO. 10010392-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Mark D. Montierth et al.

Serial No.: 09/903,201 **Examiner: Lucas Divine**

Filing Date: July 10, 2001 **Group Art Unit: 2624**

Title: Point-of-Sale Demonstration of Computer Peripherals

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) **$500.00**.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)(1)-(5)) for the total number of months checked below:

☐	one month	$ 120.00
☐	two months	$ 450.00
☐	three months	$1020.00
☐	four months	$1590.00

☐ The extension fee has already been filled in this application.

☒ (b) Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account **50-1078** the sum of $500.00. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account **50-1078** pursuant to 37 CFR 1.25.

A duplicate copy of this transmittal letter is enclosed.

Respectfully submitted,

Mark D. Montierth et al.

By David T. Millers

David T. Millers
Attorney/Agent for Applicant(s)

Reg. No. 37,396

Date: October 31, 2005

Telephone No. (408) 927-6700

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Mark D. Montierth, Richard D. Taylor, and Gary Zimmerman		
Assignee:	Agilent Technologies, Inc.		
Title:	Point-Of-Sale Demonstration Of Computer Peripherals		
Serial No.:	09/903,201	Filing Date:	July 10, 2001
Examiner:	Lucas Divine	Group Art Unit:	2624
Docket No.:	10010392-1		

San Jose, California
October 31, 2005

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P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF UNDER 37 C.F.R. §§ 1.191 & 41.37

Dear Sir:

Applicants submit this Appeal Brief pursuant to the Notice of Appeal filed in this case and mailed August 31, 2005.

I. REAL PARTY IN INTEREST

The real party in interest is the assignee, Agilent Technologies, Inc., as named in the caption above.

II. RELATED APPEALS AND INTERFERENCES

Based on information and belief, there are no appeals or interferences that could directly affect or be directly affected by or have a bearing on the decision by the Board of Patent Appeals in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-15 are pending in this case and all stand rejected.

IV. STATUS OF AMENDMENTS

There are no unentered amendments in this case. No amendments were filed subsequent to the final rejection dated May 31, 2005. Claims 1-15 as pending on appeal appear in a Claims Appendix.

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V. SUMMARY OF CLAIMED SUBJECT MATTER

The claimed subject matter is generally drawn to systems and methods for demonstrating a peripheral device such as a printer in an environment such as a retail sales outlet where connecting the printer to a host computer may be inconvenient. Embodiments of the invention can decrease development time and costs for a demonstration system by using a demonstration mode of a controller of a type normally employed in a cable connecting the peripheral to a host computer.

Independent claim 1 is drawn to a demonstration system such as demonstration system 220 shown in Fig. 2 for a peripheral (e.g., printer 130) that during normal operation, connects to a host computer (110) through a cable (120) containing a controller as shown in Fig. 1. The demonstration system (220), which is for uses when the peripheral is not connected to a host computer, includes a controller (128) and a memory (214). The memory contains demonstration data and is coupled to enable the controller to read the demonstration data from the memory when the peripheral performs a demonstration. Using a controller of the same type as employed in the cable that connects the peripheral to a host computer for normal operation reduces development and production costs for the demonstration system.

Dependent claims 7, 8, and 9 recite specific features of the controller of claim 1 and are particularly related to having alternative boot modes for normal use and demonstration. See paragraphs **[0021]** to **[0023]** of Applicants' specification.

Independent claim 11 is directed to a method of making a demonstration system (220) for a printer (130). The method includes connecting to the printer a cable containing a controller (128) that is of the same type used in a printer cable (120) that connects the printer (130) to a host computer (110) during normal operation of the printer. Demonstration data is stored in a memory (214) that is connected to the cable to enable the controller to read the demonstration data from the memory and format the data for the printer.

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VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following issues are presented to the Board of Appeals for decision:

A. Whether Claims 1-6 and 10-15 are unpatentable under 35 U.S.C. 103(a) over U.S. Pat. No. 6,753,903 (hereinafter Lin) in view of U.S. patent No. 6,747,752 (hereinafter Farago).

B. Whether Claims 7-9 are unpatentable under 35 U.S.C. 103(a) over Lin in view of Farago and further in view of U.S. Pat. No. 5,872,945 (hereinafter Wett)

VII. ARGUMENTS

Applicants request reversal of the rejections of claims 1-15 for the reasons set forth below.

A. Under 35 U.S.C. § 103(a), Claims 1-6 and 10-15 are patentable over Lin in view of Farago.

Independent claim 1 distinguishes over the combination of Lin and Farago at least by reciting, "a controller of a type employed in the cable that connects the peripheral to the host computer during normal operation."

Lin discloses using an adaptor 1 between a digital still camera (DSC) 2 and a printer 3 to eliminate the need for a host computer when printing photographs. See Fig. 1 of Lin. Lin is not directed to a demonstration system for a peripheral.

Farago is directed to demonstration systems that eliminate the need for host computers during of printer demonstrations. Farago illustrates the convention technique for demonstration systems, which employ custom ASICs that are specifically designed for the demonstration system. See for example, custom chip 3 in Fig. 1 of Farago. Also see, for example, Fargo beginning at: column 2, line 21; column 3, line 29, and column 3, line 54.

Neither Lin nor Farago suggests a demonstration system using "a controller of a type employed in the cable that connects the peripheral to the host computer." Using a control of the type recited in claim 1 has the advantages of reducing the cost and design time required to produce a demonstration system because a controller that is already designed and produced in relatively large quantity for printer cables can be easily adapted for a demonstration system. Lin and Farago whether considered separately or in combination fail to suggest achieving the advantages noted above and fail to suggest demonstration systems having the structure recited in claim 1. Accordingly, claim 1 is patentable over Lin and Farago.

In the final rejection and in the response to Applicants' prior remarks that neither Lin nor Farago disclose or suggest "a controller of a type employed in the cable that connects the peripheral to the host computer during normal operation," the Examiner

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identified the camera of Lin as corresponding to the host computer recited in claim 1. In particular, in the second paragraph of page 2 of the Final Office Action, the Examiner stated:

> the host computer claimed in the claim preamble has one claimed function, to connect to a cable. Further, generally in a printing system with a printer and a cable, the connected host computer device provides the data to be printed by the printer. The camera of Lin (digital still camera 2) acts as a host computer by providing data to be printed by the printer (picture data) as well as being connected to cable 1. During normal operation, the camera provides data to be printed.

In the advisory action dated August 11, 2005, the Examiner further indicated that "in a printing system ... the host computer provides printing data to the printer. The reference camera does this function."

Applicants acknowledge that a camera can perform some (but not all) of the functions required of a host computer. However, even if a camera can perform some of the functions of a host computer, the Examiner's interpretation "host computer" as used in claim 1 to include the camera of Lin is improper. In particular, the Examiner's interpretation is inconsistent with use of the phrase "host computer" in Applicants' specification and inconsistent with the ordinary meaning of "host computer" as that phrase would be understood by those of skill in the art. In short, one of skill in the art having knowledge of computers would not interpret the camera of Lin as being a "host computer" as recited in Claim 1. During Examination, the broadest reasonable interpretation of a claim must be consistent with the interpretation that those skilled in the art would reach. See *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

As noted above, Lin and Farago fail to suggest the demonstration system of Claim 1 because neither reference suggests use of "a controller of a type employed in the cable that connects the peripheral to the host computer during normal operation." In regard to this claim language, the Examiner in the Advisory Action, pointed out that "applicant is not claiming a host computer" in claim 1 and also indicated that "the recitation of host computer has not been given patentable weight because the recitation is in the preamble" of claim 1. Although a "host computer" is not an element of claim 1 and the phrase "host computer" first appears in the preamble of claim 1, the Examiner errs in not giving weight to the "host computer" as used in regard to the "controller" recited in claim 1. The controller is clearly an element of claim 1, and the phrase "host computer" in this element is part of a limitation indicating the type of controller being claimed in claim 1.

In regard to the element "a controller of a type employed in the cable that connects the peripheral to the host computer during normal operation," the Examiner in the also

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pointed out that "the term 'normal operation' includes when the camera is connected to the printer via the cable. Different printing systems have different 'normal operations.'" However, normal operation with a camera is not the normal operation at issue in this appeal. Claim 1 recites, "a controller of a type employed in the cable that connects the peripheral to the host computer during normal operation." As noted above, Lin and Farago fail to disclose or suggest use of a control of the type recited in claim 1.

Accordingly, claim 1 is patentable over the combination of Lin and Farago because the combination fails to teach or suggest all of the elements of claim 1.

Claim 1 is also patentable over the combination of Lin and Farago because Lin is not analogous art that one of skill in the art would look to as being related to a demonstration system for a printer. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In particular, Lin is directed to an adapter for cameras and is thus outside the field of endeavor of Applicants' invention, which is provision of a demonstration system. Further, Lin is not reasonably pertinent to the particular problem of providing a system for in-store demonstration of a printer, which was the Applicants' concern. Accordingly, it would not have been obvious at the time Applicants' invention was made to combine Lin and Farago to produce a demonstration system as recited in claim 1.

In the advisory action, the Examiner indicated motivations for combining features of the camera system of Lin with the demonstration system of Farago, for example, to provide more options for a sales person demonstrating a printer. However, Applicants submit that the camera system of Lin in not analogous or pertinent to demonstration systems such as disclosed by Farago, so that it would not have been obvious for one of skill in the art to consider combining the features of a camera system with a demonstration system. In other words, the Examiner's proposal of using a camera system for a demonstration system may indeed be a good idea for some printers, but Lin and Farago provide no suggestion that the two technologies, which have very different challenges and purposes, are suitable for combination.

For the above reasons, claim 1 is patentable over the combination of Lin and Farago.

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Claims 2-6 and 10, which depend from claim 1, are patentable over the combination of Lin and Farago for at least the same reasons that claim 1 is patentable over the combination of Lin and Farago.

Independent claim 11 distinguishes over Lin and Farago by reciting, "A method of making a demonstration system for a printer, comprising ...: connecting to the printer a cable containing a controller that is of a type used in a printer cable that connects the

printer to a host computer during normal operation of the printer; storing demonstration data in a memory; and connecting the memory to the cable to enable the controller to read the demonstration data from the memory and format the data for the printer."

Lin and Farago fail to suggest a demonstration system using a controller that is of a type used in a printer cable that connects the printer to a host computer during normal operation. Instead, Lin discloses a camera-printer system, and Farago discloses a demonstration system including custom ASICs for control functions. Claim 11 is thus patentable over the combination of Lin and Farago.

Further, claim 11 is patentable over the combination of Lin and Farago because Lin is not analogous art that one of skill in the art would look to for a demonstration system.

Claims 12-15 depend from claim 11 and are patentable over the combination of Lin and Farago for at least the same reasons that claim 11 is patentable over the combination of Lin and Farago.

For the above reasons, Applicants respectfully submit that pending Claims 1-6 and 10-15 are allowable. Accordingly, Applicants submit the present rejection of claims 1-6 and 10-15 is unfounded and request that this rejection be reversed.

B. Claims 7-9 are patentable under 35 U.S.C. 103(a) over Lin in view of Farago and further in view of Wett.

Claims 7-9 depend from claim 1, which is patentable over Lin and Farago for the reasons given above. In particular, Lin and Farago fail to suggest a demonstration system using a controller that is of a type used in a printer cable that connects the printer to a host computer during normal operation. Wett is directed to self-contained processor systems and particularly to a bus translator for translation from an MX bus to a system bus protocol. Wett fails to disclose or suggest either a demonstration system or a controller that is of a type used in a printer cable that connects the printer to a host computer during normal operation. Accordingly, Wett does not provide the elements of claim 1 that are missing from the combination of Lin and Farago. Claim 1 and claims 7-9, which depend from claim 1, are thus patentable over the combination of Lin, Farago, and Wett.

Claim 7 further distinguishes over the combination of Lin, Farago, and Wett by reciting, "the controller is operable in a first mode and a second mode, wherein in the first mode, the controller boots from an internal memory, and in the second mode, the controller boots from the external memory." Wett does describe a controller having

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internal and external boot capabilities but in a context unrelated to demonstration systems for peripherals. The combination of Lin, Farago, and Wett fails to disclose or suggest a motivation for using a controller having alternative boot modes in a demonstration system.

Claim 8 further distinguishes over the combination of Lin, Farago, and Wett by reciting, "circuitry connected to the controller to cause the controller to operate only in the second mode." The combination of Lin, Farago, and Wett fails to suggest a demonstration system using a controller having two boot modes and then only permitting operation in one of the boot modes. In particular, prior demonstration systems as described in Farago have used custom ASICs, and the combination of Lin, Farago, and Wett fails to suggest a reasons for implementing an unused boot mode in a custom ASIC.

For the above reasons, Applicants respectfully submit that pending Claims 7-9 are allowable. Accordingly, Applicants submit the present rejection of claims 7-9 is unfounded and request that this rejections be reversed.

Please contact the undersigned attorney at (408) 927-6700 if there are any questions concerning this Appeal Brief or the application generally.

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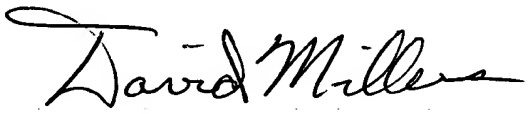
Respectfully submitted,



David Millers
Reg. No. 37,396

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CLAIMS APPENDIX

Claims 1-15, which are the claims involved in this appeal, are copied below.

1. (Original) For a peripheral that during normal operation, connects to a host computer through a cable containing a controller, a demonstration system comprising:

a controller of a type employed in the cable that connects the peripheral to the host computer during normal operation; and

a memory that is external to the peripheral, contains demonstration data, and is coupled to the controller to enable the controller to read the demonstration data from the memory for the peripheral to perform a demonstration without being connected to the host computer.

2. (Original) The demonstration system of claim 1, wherein the peripheral is a printer.

3. (Original) The demonstration system of claim 2, wherein:

the controller in the cable operates to format data from the host computer for a print operation of the printer; and

the controller in the demonstration system operates to format data from the memory as required for the print operation of the printer.

4. (Previously Presented) The demonstration system of claim 1, wherein the demonstration system further comprises:

a connector having a pin layout for connection to the printer;

a first enclosure containing the controller; and

a second enclosure containing the memory.

5. (Previously Presented) The demonstration system of claim 4, wherein the connector, the first enclosure, and the second enclosure are substantially identical to matching elements of the cable that connects the peripheral to the host computer during the normal operation.

6. (Original) The demonstration system of claim 1, wherein the memory is a non-volatile memory.

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7. (Original) The demonstration system of claim 1, wherein the controller is operable in a first mode and a second mode, wherein in the first mode, the controller boots from an internal memory, and in the second mode, the controller boots from the external memory.

8. (Original) The demonstration system of claim 7, further comprising circuitry connected to the controller to cause the controller to operate only in the second mode.

9. (Original) The demonstration system of claim 7, wherein the external memory further comprises demonstration code that the controller executes.

10. (Original) The demonstration system of claim 1, wherein the external memory further comprises demonstration code that the controller executes.

11. (Previously Presented) A method of making a demonstration system for a printer, comprising the steps of:

connecting to the printer a cable containing a controller that is of a type used in a printer cable that connects the printer to a host computer during normal operation of the printer;

storing demonstration data in a memory; and

connecting the memory to the cable to enable the controller to read the demonstration data from the memory and format the data for the printer.

12. (Original) The method of claim 11, wherein the controller has a computer interface and a memory interface, the computer interface is connected through the printer cable to the host computer during normal operation, and wherein connecting the memory comprises connecting the memory through the cable to the memory interface.

13. (Original) The method of claim 12, wherein the computer interface implements a protocol for serial communication with the host computer and the memory interface implements an interface for access in a non-volatile memory.

14. (Original) The method of 13, wherein the computer interface implements the protocol required for connection to a universal serial bus, and the memory interface implements accesses to a serial EEPROM.

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15. (Original) The method of claim 12, wherein the memory interface comprises circuitry for access of non-volatile memory.

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